IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Toshiaki KAWACHI et al

Application No.: 10/821,965

Filed: April 12, 2004

For: SLIDE MEMBER

Art Unit: 1775

Examiner: J. J. Zimmerman

Washington, D.C.

Atty.'s Docket: KAWACHI=5

Confirmation No.: 2082

Date: January 13, 2006

Customer Service Window, **Mail Stop Amendment**
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, 401 Dulany Street
Alexandria, Virginia 22314

Sir:

Transmitted herewith is a Reply (No Amendment): Request for Reconsideration in the above-identified application.

[ ] Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

[XX] No additional fee is required.

[ ] The fee has been calculated as shown below:

	(Col. 1) CLAIMS REMAINING AFTER AMENDMENT		(Col. 2) HIGHEST NO. PREVIOUSLY PAID FOR	(Col. 3) PRESENT EXTRA EQUALS	SMALL ENTITY RATE	SMALL ENTITY ADDITIONAL FEE	OR	OTHER THAN SMALL ENTITY RATE	OTHER THAN SMALL ENTITY ADDITIONAL FEE
TOTAL	*	MINUS	** 20	0	x 25	$		x 50	$
INDEP.	*	MINUS	*** 3	0	x 100	$		x 200	$
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ 180	$		+ 360	$
					ADDITIONAL FEE TOTAL	$	OR	TOTAL	$

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[ ] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity		Other Than Small Entity	
Response Filed Within		Response Filed Within	
[ ] First	- $ 60.00	[ ] First	- $ 120.00
[ ] Second	- $ 225.00	[ ] Second	- $ 450.00
[ ] Third	- $ 510.00	[ ] Third	- $ 1020.00
[ ] Fourth	- $ 795.00	[ ] Fourth	- $ 1590.00
Month After Time Period Set		Month After Time Period Set	

[ ] Less fees ($_____) already paid for ___ month(s) extension of time on _____.

[ ] Please charge my Deposit Account No. 02-4035 in the amount of $_____.

[ ] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of $

[ ] A check in the amount of $_____ is attached (check no.).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: KAWACHI=5

In re Application of:	)	Confirmation No.: 2082
Toshiaki KAWACHI et al	)	Art Unit: 1775
Appln. No.: 10/821,965	)	Examiner: J.J. Zimmerman
Filing Date: April 12, 2004	)	January 13, 2006
For: SLIDE MEMBER	)	

REPLY (NO AMENDMENT[1]): REQUEST FOR RECONSIDERATION

Customer Service Window, Mail Stop Amendment
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

Applicants are in receipt of the Office Action mailed October 13, 2005, and Reply as follows:

Acknowledgement by the PTO of the receipt of applicants' papers filed under Section 119 is noted.

The Office Action of October 13, 2005, and the prior art relied upon therein have been carefully studied. The claims in the application remain as claims 1-8, and these claims are respectfully submitted to define novel and unobvious subject matter, thereby warranting their allowance.

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[1] As no amendment is being filed, the formatting requirements of 37 CFR 1.121 do not apply.

Applicants accordingly respectfully request favorable reconsideration and allowance.

Claims 1-8 have been rejected alternatively as anticipated under Section 102, or obvious under Section 103, from published U.S. application 2003/0048961 in the name of Kawachi et al, now U.S. patent 6,863,441, hereinafter "Kawachi". This rejection is respectfully traversed.

The invention is based on the discovery that the Bi layer in a crystal configuration, in which a Miller index (202) face has the index of orientation of not less than 30% and the X-ray diffracted intensity R(202) assumes a maximum value as compared with those of other faces, is especially excellent in its anti-seizure properties. Thus, the invention comprises the feature that the overlay layer is in the above crystal configuration.

As stated in paragraph [0025] of the Kawachi publication, the overlay layer is formed by a PR electroplating method under the conditions of 2 to 10 A/dm^2 at the side of the positive electrode (the anode) for a time of 0.001 to 0.1 seconds, and 0.1A to 0.01A/dm^2 at the side of negative electrode (the cathode) for a time of 0.0001 to 0.001 seconds.

This is not the same as in the present invention. Thus, contrary to what is stated in the Official Action in the

sentence spanning pages 3 and 4, there is a difference of conditions between electroplating according to the present invention and electroplating according to Kawachi in that the time of application of the anode current to produce applicants' claimed product is 10 to 20% of the time of current application of cathode current, whereas in Kawachi the time of anode current application (at the positive electrode) is longer than the time of cathode current application (at the negative electrode). In other words, to produce applicants' claimed product, the application of anode current is a small fraction of the time of application of cathode current, whereas in Kawachi the anode current is applied for a longer period of time, exactly opposite to the present invention.

Under the conditions of Kawachi, the index of orientation of the Miller index (202) face in the Bi layer is 5 to 25%. When the index of orientation of (202) face is not more than 15%, the x-ray diffracted intensity R(202) of the (202) face does not assume a maximum value as compared with those of other faces. Thus, the form of crystal orientation in Kawachi is quite different from that of the present invention.

It then follows that Kawachi absolutely does not inherently produce applicants' claimed product. Under Section

102, inherency must be reasonably certain. For example, please see *In re Brink*, 164 USPQ 247, 249:

> Absent a showing [by the PTO] of some **reasonable certainty** of inherency, the rejection... under 35 U.S.C. 102 must fail.
> (emphasis added)

Also see *Ex parte Cyba*, 155 USPQ 756, 757, (1967), and *In re Oelrich*, 212 USPQ 323, 326 (1981). There is no reasonable certainty that Kawachi's process would produce applicants' product; therefore, inherency is neither inevitable nor reasonably certain, and inherency (which does not exist in the present case) cannot be relied upon.

The situation is similar with respect to any rejection based on Section 103. Please see *In re Rijckaert*, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993), where the Court stated:

> "The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient [to establish inherency]" *In re Oelrich*, 666 F.2d 578# 581-82, 212 USPQ 323,326 (CCPA 1981) (citations omitted) (emphasis added). "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444,448, 150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. *See In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989) (emphasis in *Rijckaert)*

As the court stated, "obviousness cannot be predicated on what is unknown."

The fact of the matter is that by following the teachings of Kawachi one either definitely does not produce applicants' product, or at most does not **necessarily** produce applicants' product. That means that inherency is neither inevitable nor reasonably certain, and cannot be properly relied upon by the PTO.

Moreover, the differences in the product as claimed over the product of Kawachi are significant. These differences would not have been obvious to the person of ordinary skill in the art from reading Kawachi, at the time the present invention was made.

Kawachi neither anticipates nor makes obvious the claimed subject matter. The rejections should be withdrawn, and such is respectfully requested.

The prior art documents of record but not applied by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of applicants' claims.

Applicants believe that all issues raised in the Official Action have been addressed above in a manner which

should lead to patentability of applicants' claims.

Accordingly, applicants respectfully request favorable reconsideration and allowance.

Respectfully submitted,

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